

FAX COVER SHEET**THE ECLIPSE GROUP**

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Send to: Office of PCT Legal Administration Attn: Shakeel Ahmed	From: Mariana Paula Noli
Company: USPTO	Date: May 12, 2009
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- ☐ Urgent
- ☐ Reply ASAP
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- ☐ For your information

Total pages, including cover: 15**Comments:**

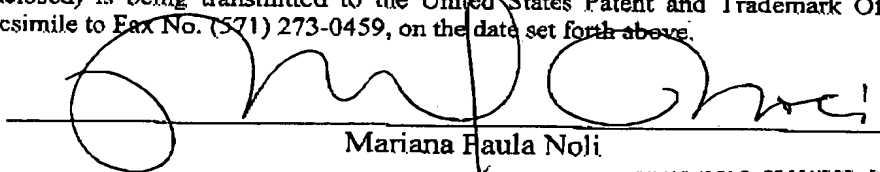
Applicant: SiRF Technology, Inc.
Title: "Signal Processing System for Satellite Positioning Signals"
Serial No.: 10/570,833 - Attorney Docket No.: ST02042USU2 (281-US-U2)

Please acknowledge receipt of the following documents:

- 1) Petition for the Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b) (2 pages);
- 2) Response to Decision on Petition (2 pages);
- 3) Decision on Petition mailed September 3, 2008 (3 pages);
- 3) Combined Declaration and Power of Attorney of Inventor Chittharanjan A. Dasanncharya (4 pages);
- 4) Statement of Robert Tso (signed) (2 pages); and
- 5) Credit Card Authorization in the amount of USD \$1,620.00 (1 page).

CERTIFICATE OF TRANSMISSION

I hereby certify that this document (along with any papers referenced as being attached or enclosed) is being transmitted to the United States Patent and Trademark Office via facsimile to Fax No. (571) 273-0459, on the date set forth above.


Mariana Paula Noli

05/13/2009 SBASHEIR 00000002 10570833

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1620.00 OP

PTO/SB/64/PCT (05-07)

Approved for use through 02/28/2010. OMB 0651-002

U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

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**PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT
DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**Docket Number
(Optional)
ST02042USU2(281-US-UFirst Named Inventor: Paul A. UnderbrinkInternational (PCT) Application No.: PCT/US2004/028926U.S. Application No.: 10/570,833
(if known)Filed: 02 September 2004

Title:

Signal Processing System for Satellite Positioning SignalsAttention: PCT Legal Staff
Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The above-identified application became abandoned as to the United States because the fees and documents required by 35 U.S.C. 371(c) were not filed prior to the expiration of the time set in 37 CFR 1.495(b) or (c) as applicable. The date of abandonment is the day after the date on which the 35 U.S.C. 371(c) requirements were due. See 37 CFR 1.495(h).

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee
- (2) Proper reply
- (3) Terminal disclaimer with disclaimer fee which is required for all international applications having an international filing date before June 8, 1995; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee☐ Small entity - fee \$ _____ (37 CFR 1.17(m)). Applicant claims small entity status.
See 37 CFR 1.27.☒ Other than small entity - fee \$ 1,620.00 (37 CFR 1.17(m))**2. Proper reply**A. The proper reply (the missing 35 U.S.C. 371(c) requirement(s)) in the form of
Response to Decision on Petition (identify type of reply):☐ has been filed previously on _____☒ is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9188 and select option 2.

PTO/SB/64/PCT (05-07)

Approved for use through 02/28/2010. OMB 0651-002

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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

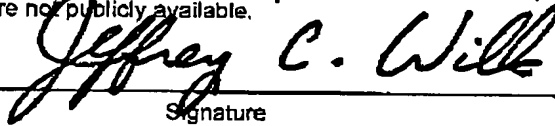
3. Terminal disclaimer with disclaimer fee

- ☒ Since this international application has an international filing date on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ for a small entity or \$ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. Statement. The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.



Signature

May 12, 2009

Date

Jeffrey C. Wilk

42,227

Typed or Printed Name

Registration Number, if applicable

1920 Main Street, Suite 150

(818) 488-8148

Address

Telephone Number

Irvine, CA 92614

Address

- Enclosures: ☒ Response
- ☒ Fee Payment
- ☐ Terminal Disclaimer
- ☒ Other (please identify):

Combined Declaration and Power of Attorney of Chittharanajn A. Dasannacharya; and
Statement of Robert Tso.

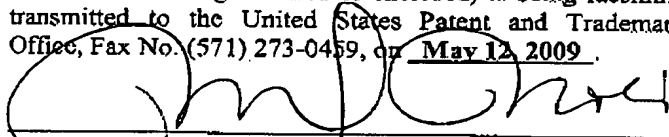
PATENT
Docket No.: ST02042USU2 (281-US-U2)
10/570,833

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Underbrink et al. DOCKET NO.: ST02042USU2 (281-US-U2)
SERIAL NO.: 10/570,833 GROUP ART UNIT: Not Yet Assigned
DATE FILED: March 1, 2004 EXAMINER: Not Yet Assigned
CONFIRMATION NO.: 4057
TITLE: SIGNAL PROCESSING SYSTEM FOR SATELLITE POSITIONING
 SIGNALS

CERTIFICATE OF TRANSMISSION

I hereby certify that this document (along with any paper referred to as being attached or enclosed) is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571) 273-0459, on May 12, 2009.


Mariana Paula Noli

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

RESPONSE TO DECISION ON PETITION

This Response to Decision on Petition is submitted in response to that certain Decision on Petition mailed September 3, 2008, a copy of which is submitted herewith, together with a Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b).

The Decision on Petition dismissed Applicant's Petition under 37 CFR § 1.497(d) and Petition under § 1.47(a) filed with a Response to Notification of Defective Response filed June 30, 2008.

PATENT
Docket No.: ST02042USU2 (281-US-U2)
10/570,833

As for the Petition under 37 CFR § 1.47(a) regarding inventor Chittharanjan A. Dasannacharya, Applicant submits herewith a Combined Declaration and Power of Attorney signed by said Chittharanjan A. Dasannacharya, thus rendering moot the Petition under 37 CFR § 1.47(a).

Applicant also submits herewith the Statement of Robert Tso together with a Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b) and the appropriate fee.

Accordingly, all of the deficiencies noted in the aforesaid Notification of Defective Response have been remedied. Therefore, based on the foregoing, Applicant requests that the accompanying Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b) be granted.

Respectfully submitted,
Paul Underbrink et al.

Dated: May 12, 2009

By: Jeffrey C. Wilk

Jeffrey C. Wilk

Registration No. 42,227

Phone: (818) 488-8148

Fax: (814) 332-4205

The Eclipse Group LLP
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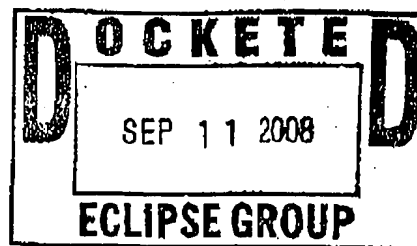


UNITED STATES PATENT & TRADEMARK OFFICE

03 SEP

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 108
ALEXANDRIA, VA 22311-0108
www.uspto.gov

THE ECLIPSE GROUP LLP
10605 BALBOA BLVD., SUITE 300
GRANADA HILLS CA 91344



In re Application of: UNDERBRINK ET AL.
U.S. Application No.: 10/570,833
PCT Application No.: PCT/US2004/028926
Int. Filing Date: 02 September 2004
Priority Date: 23 February 2004
Atty Docket No.: ST02042USU2 (281-US-U2)
For: Signal Processing System for Satellite
Positioning Signals

DECISION

This is in response to applicant's Petition under 37 CFR 1.48(a), requesting a Correction of Inventorship, and Petition under 37 1.47(a), requesting acceptance of the application without the signature of one of the co-inventors, filed 30 June 2008.

BACKGROUND

On 02 September 2004, applicant filed international application PCT/US2004/028926, which claimed priority of an earlier United States application filed 02 September 2003. The deadline for paying the basic national fee in the United States under 35 U.S.C. 371 and 37 CFR 1.495 was 02 March 2006.

On 01 March 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 31 August 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 02 April 2007, Applicant sent in petition for extension of time and response to the Notification of Missing Requirements.

On 20 August 2007, the DO/EO/US mailed a Notification of Abandonment.

On 20 August 2007, the DO/EO/US mailed Notice of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.495.

Application No.: 10/570833

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On 20 September 2007, Applicant filed a petition under 37 CFR 1.181 to withdraw the Holding of Abandonment. The decision of 08 November 2007 stated that the petition was granted, the notification of Abandonment mailed 20 August 2007 is vacated, and the Notice of Acceptance of Application under 35 U.S.C. 371 mailed 20 August 2007 is vacated.

On 29 May 2008, a Notification of Defective Response (Form PCT/DO/EO/916) was mailed with a one month response period.

DISCUSSION

The petition under 37 CFR 1.48(a) has been treated under 37 CFR 1.497(d). Applicant states that Robert Tso was inadvertently named as an inventor in a combined declaration and power of attorney filed 02 April 2007 signed by Nicolas Vantalon. However, Robert Tso's statement requesting withdrawal as a co-inventor was not signed. The petition indicated that a signed statement by Robert Tso would follow in a supplemental response. Applicant submitted a supplemental statement signed by Robert Tso on 01 July 2008 and a supplemental response with a substitute combined declaration and power of attorney signed by inventor Nicholas Vantalon which does not list Robert Tso as an inventor. However, the supplemental responses were received after the one-month period for response and as such, Applicant has not fully complied with the requirements of the Notification of Defective Response. Accordingly, the application is abandoned.

Regarding the petition under 37 CFR 1.47(a), a submission must include:

(1) proof that the non-signing inventor was presented with the application papers and refused to sign the oath or declaration or that the non-signing inventor could not be found or reached after diligent effort;

(2) the required fee

(3) the last known address of the non-signing inventor

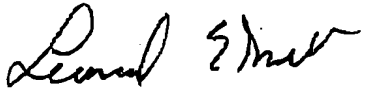
Applicant has submitted a copy of an Express Mail envelope containing a complete copy of the present application, sent by the U.S. Postal Service to Chittharanjan Dassannacharya, with the envelope marked as "no such person in this address". Applicant has failed to set forth further efforts to locate Mr. Dassannacharya. Accordingly, Applicant has not provided sufficient evidence of diligent effort to locate the inventor.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 is DISMISSED and the application is hereby ABANDONED.

Application No.: 10/570833

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Leonard Smith
PCT Legal Examiner
PCT Legal Office
Telephone: 571-272-3297
Facsimile: 571-273-0459



Katherine Moran
PCT Legal, Detailee
PCT Legal Office
Telephone: 571-272-6095

Atty. Docket No. ST02042USU2 (281-US-U2)

PATENT

COMBINED DECLARATION AND POWER OF ATTORNEY

As a below-named inventor, I hereby declare that:

1. My residence, post office address, and citizenship are as stated below next to my name.
2. I believe I am the original and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention titled:

SIGNAL PROCESSING SYSTEM FOR SATELLITE POSITIONING SIGNALS

the specification of which (check one):

- ☐ is attached hereto.
- ☒ was filed on: September 2, 2004 As
Application Serial No.: PCT/US2004/028926
☐ and was amended on: _____

3. I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims.

4. I acknowledge the duty to disclose information which is material to patentability as described in 37 C.F.R. 1.56, which is defined on the attached page.

5. I hereby claim the benefit under 35 U.S.C. 119(e) of any United States provisional patent applications listed below.

Prior United States Application(s)

(Application Serial No.)	(Filing Date)	(Status)-(Patented, Pending, Abandoned, Expired)
<u>60/499,961</u>	<u>September 2, 2003</u>	<u>Expired</u>
(Application Serial No.)	(Filing Date)	(Status)-(Patented, Pending, Abandoned, Expired)
<u>60/546,816</u>	<u>February 23, 2004</u>	<u>Expired</u>
(Application Serial No.)	(Filing Date)	(Status)-(Patented, Pending, Abandoned, Expired)
<u>60/547,385</u>	<u>February 23, 2004</u>	<u>Expired</u>

6. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

7. I hereby appoint Jennifer H. Hamilton (Reg. No. 41,814), Francisco A. Rubio-Campos (Reg. No. 45,358), Gregory B. Gulliver (Reg. No. 44,138), Jeffrey C. Wilk (Reg. No. 42,227), David P. Gloekler (Reg. No. 41,037), Kevin E. Flynn (Reg. No. 37,325), Enrique Perez (Reg. No. 43,853), and other registered patent attorneys and agents of the firm The Eclipse Group, as my attorneys with full power of substitution and revocation, to prosecute this application and to transact all business in the United States Patent and Trademark Office connected therewith.

Please direct all correspondence to:

Jennifer H. Hamilton
THE ECLIPSE GROUP LLP
10605 Balboa Blvd., Suite 300
Granada Hills, CA 91344

Please direct telephone calls to Jennifer H. Hamilton at 818.488.8141 (facsimile 818.332.4205).

Full name of first joint inventor: Paul A. Underbrink

Date:

Residence and Post Office Address: 25212 Calle del Lago
Lake Forest, CA 92630
Citizenship: US

Full name of second joint inventor: Henry D. Falk

Date:

Residence and Post Office Address: 3150 Julian Avenue
Long Beach, CA 90808
Citizenship: US

Full name of third joint inventor: Steven A. Gronemeyer

Date:

Residence and Post Office Address: 6908 Wilton Drive NE
Cedar Rapids, IA 52402
Citizenship: US

Full name of fourth joint inventor: Chittharanjan A. Dasannacharya
Date: 16-March-2009 *Chittharanjan*
Residence and Post Office Address: C-302, Temple Meadows, 27th Cross,
BSK II (2nd Stage, Banashankari), Bangalore
560 070 India
Citizenship: India

Full name of fifth joint inventor: Charles P. Norman
Date:
Residence and Post Office Address: 6071 Softwind Drive
Huntington Beach, CA 92647
Citizenship: US

Full name of sixth joint inventor: Nicolas Vantalou
Date:
Residence and Post Office Address: 15 bis rue Chateaufort
Nice, 0600, France
Citizenship: France

Full name of seventh joint inventor: Vojislav Protic
Date:
Residence and Post Office Address: 765 San Antonio Road, # 19
Palo Alto, CA 94303
Citizenship: US

Section 1.56 Duty to Disclose Information Material to Patentability.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

(1) prior art cited in search reports of a foreign patent office in a counterpart application, and

(2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

(1) Each inventor named in the application; .

(2) Each attorney or agent who prepares or prosecutes the application; and

(3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

(d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

(c) In any continuation-in-part application, the duty under this section includes the duty to disclose to the Office all information known to the person to be material to patentability, as defined in paragraph (b) of this section, which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

Tso 14

PATENT

Docket No.: ST02042USU2(281-US-U2)
10/570,833

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Underbrink et al.

DOCKET NO.: ST02042USU2(281-US-U2)

SERIAL NO.: 10/570,833

GROUP ART UNIT: Not Yet Assigned

DATE FILED: September 2, 2004

EXAMINER: Not Yet Assigned

CONFIRMATION NO.: 4057

TITLE: SIGNAL PROCESSING SYSTEM FOR SATELLITE POSITIONING
SIGNALSCertificate of Transmission

I hereby certify that this document (along with any paper referred to as being attached or enclosed) is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571) 273-8300, on May 12, 2008


Mariana Paula NoliSTATEMENT OF ROBERT TSO

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I, ROBERT TSO, submit this statement in support of the Request to Correct Inventorship filed concurrently herewith.

1. I am one of the joint inventors named in a Combined Declaration and Power of Attorney filed in the above-identified patent application on April 2, 2007.
2. The inclusion of my name as an inventor in said Combined Declaration and Power of Attorney was made in error, and therefore I join in the Request to Correct Inventorship filed concurrently herewith.

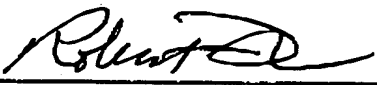
Tso 13

PATENT
Docket No.: ST02042USU2(281-US-U2)
10/570,833

3. The foregoing inventorship error occurred without any deceptive intention
on my part.

Respectfully submitted,

Dated: 28-JUN-2008

By: 
Robert Tso
1774 Gates Ave.
Manhattan Beach, CA 90266